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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,553	01/25/2000	Jeffrey A. Morgan	10992213-1	7289

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EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/490,553

Applicant(s)

MORGAN ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-18 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification, there are no line numbers in the claims. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

### Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4-5 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Is external network referring to external Internet of claim 1? If not, does external network include external Internet? The use of external network is not fully described in the specification.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Ee, U.S. Patent 6,466,203, in view of Smith, U.S. Patent 5,974,085.

7. As per claim 1, Van Ee taught the invention substantially as claimed including a system for providing Internet-related services to a handheld device (col.1, lines 26-29), comprising:

- a. A client module embedded in the handheld device to enable the handheld device to send a URL via a communication link, wherein the URL indicates a desired web page (col.2, lines 21-26, 53-59, col.3, line 67 to col.4, line 1);
- b. A web access module coupled to external Internet to access and retrieve the desired web page from a remote web server via the external Internet (col.3, lines 65-66, col.4, lines 4-5);
- c. A render system to render the retrieved web page to the user of the handheld device (col.2, lines 39-41, col.4, lines 4-5).

8. Van Ee did not specifically teach that a receiver that receives the URL sent from the handheld device via the communication link, the web access module is coupled to the receiver

and the render system is coupled to the web access module. Smith taught a wireless modem to include a receiver that receives the URL sent from the handheld device via the communication link (col.1, lines 60-63, col.3, lines 34-43), a web access module coupled to the receiver and external Internet to access and retrieve the desired web page from a remote web server via the external Internet (col.1, line 59 to col.2, line 5, lines 41-46, col.3, lines 8-18), and a render system coupled to the web access module to render the retrieved web page to the user of the handheld device (col.3, lines 44-50). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Van Ee and Smith and add or replace the built-in wireless modem in Van Ee's handheld device with Smith's wireless modem where Smith's wireless modem can be connected to different handheld devices.

9. As per claim 2, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee further taught that the handheld device fits into a user's palm (col.1, lines 26-29, col.2, lines 50-54).

10. As per claim 3, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee further taught a memory in the handheld device that stores the URL (col.3, lines 55-59).

11. As per claim 4, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee further taught a communication module in the handheld device that receives the URL

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from a remote site via an external network coupled to the communication module (col.3, lines 65-66).

12. As per claim 5, Van Ee and Smith taught the invention substantially as claimed in claim 4. Van Ee and Smith did not specifically teach that the external network is a wireless network. However, it is well known in the art that handheld devices include cellular phones and pagers where the use of wireless network such as satellite network is needed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Van Ee, Smith and the use of wireless network to provide cellular phone and pager users the same benefits of the invention.

13. As per claim 6, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee further taught that the handheld device can be selected from a group comprising a pager, a cellular phone, a personal organizer, a watch, a palm pilot device, and an information appliance (col.1, lines 13-15, 26-29, col.2, lines 50-54).

14. As per claim 7, Van Ee and Smith taught the invention substantially as claimed in claim 1. Smith further taught that the receiver, the web access module, and the render system all physically reside within a single enclosure separate from the handheld device (fig.2).

15. As per claims 8-9, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee and Smith did not specifically teach that the communication link is a wireless

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communication link of an infrared, a radio, a microwave, or a laser type. However, Smith did disclose that the communication can be through "well-known techniques" (col.3, lines 54-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Van Ee, Smith and a use of wireless communication link of any type to eliminate the needs for using physical cables and fully advance the mobility of handheld devices.

16. As per claims 10-11, Van Ee and Smith taught the invention substantially as claimed in claim 1. Van Ee further taught that the web access module communicates with the remote web server via the Internet using an open standard communication protocol such as HTTP (col.2, lines 54-61).

17. As per claim 12, Van Ee and Smith taught the invention substantially as claimed in claim 1. Smith further taught that the render system is one of a printer system, a display system, a projection display system, a user interface display system, an audio/video player system, a Web television system, and a combination thereof (col.3, lines 44-50).

18. As per claim 13, Van Ee taught the invention substantially as claimed including a system for providing Internet-related services to a handheld device (col.1, lines 26-29), comprising:

- a. A web access module coupled to external Internet to access and retrieve the desired web page from a remote web server via the external Internet (col.3, lines 65-66, col.4, lines 4-5);

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- b. A render system to render the retrieved web page to the user of the handheld device (col.2, lines 39-41, col.4, lines 4-5).

19. Van Ee did not specifically teach that a receiver that receives the URL sent from the handheld device via the communication link, the web access module is coupled to the receiver and the render system is coupled to the web access module and that the receiver, the web access module and the render system all physically reside within the system while the handheld device is physically separated from the system. Smith taught a wireless modem to include a receiver that receives the URL sent from the handheld device via the communication link (col.1, lines 60-63, col.3, lines 34-43), a web access module coupled to the receiver and external Internet to access and retrieve the desired web page from a remote web server via the external Internet (col.1, line 59 to col.2, line 5, lines 41-46, col.3, lines 8-18), a render system coupled to the web access module to render the retrieved web page to the user of the handheld device (col.3, lines 44-50), and that the receiver, the web access module and the render system all physically reside within the system while the handheld device is physically separated from the system (fig.2). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Van Ee and Smith and replace the built-in wireless modem in Van Ee's handheld device with Smith's wireless modem where Smith's wireless modem can be used separately and connected to different handheld devices.

20. As per claim 14, Van Ee and Smith taught the invention substantially as claimed in claim

13. Smith further taught that the render system is one of a printer system, a display system, a



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projection display system, a user interface display system, an audio/video player system, a Web television system, and a combination thereof (col.3, lines 44-50).

21. As per claims 15-16, Van Ee and Smith taught the invention substantially as claimed in claim 13. Van Ee further taught that the web access module communicates with the remote web server via the Internet using an open standard communication protocol such as HTTP (col.2, lines 54-61).

22. As per claims 17-18, Van Ee and Smith taught the invention substantially as claimed in claim 13. Van Ee and Smith did not specifically teach that the communication link is a wireless communication link of an infrared, a radio, a microwave, or a laser type. However, Smith did disclose that the communication can be through "well-known techniques" (col.3, lines 54-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Van Ee, Smith and a use of wireless communication link of any type to eliminate the needs for using physical cables and fully advance the mobility of handheld devices.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kikinis, U.S. Patent 6,243,596, disclosed Cellular phone with the capability to access the Internet.

Gershman et al, U.S. Patent 6,401,085, disclosed mobile communication.

24. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-5140.

ksl  
December 10, 2002

  
ZARNI MAUNG  
PRIMARY EXAMINER